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Docket No.: 5700011USU2 (100-US-U2)

REMARKS

Claims 1-7 and 12-18 are pending in this application. Applicant has not amended any of the claims. Applicant is traversing the claim rejections and submitting a terminal disclaimer.

Response to 35 U.S.C. §103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner rejected claims 1, 3-7, 15 and 17 under 35 U.S.C. 103(a) as being unpatentable over Woo et al. US Patent No. 6,125,135 in view of applicant's admitted prior art on page 8, lines 7-10.

Not all claim limitation taught or suggested by cited art

The prior art reference of the '135 patent in view of the page 8, lines 7-10 of the patent application, does not teach or suggest all of Applicant's claim limitations. The Examiner stated in the Office Action that the '135 patent fails to teaches that the IF filter is an active filter it also fails to teach that the noise bandwidth of the GPS receiver is set by the IF active filter. The Examiner goes on to state that "configuring the IF filter as an active filter is old and well established in the art given that, it would have been obvious to one skilled in the art to configure Woo et al. as an active filter as such filter consumes less chip area."

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Applicant does not simply claim "configuring the IF filter as an active filter". The claim element must be read in view of the whole claim. The IF filter in the Applicant's application is in a GPS receiver as shown by the preamble of the claim. Further, the active filter is claimed as "an I/Q Intermediate Frequency (IF) active filter" and not simple "a IF filter as an active filter" as stated in the rejection by the Examiner.

The '135 patent does not teach using an IF active filter, thus the element is missing. The act of configuring an active filter is irrelevant if the element of an active filter is not taught or suggested by the references.

Therefore, claims 1, 3-7, 15 and 17 are in condition for allowance because not all elements are taught by the combination of references cited by the Examiner.

Must be some suggestion or motivation to combine

A prima facie case of obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings of the '135 patent with knowledge of one of ordinary skill in the art of configuring an active filter. The combination of the '135 patent and the knowledge of configuring, in general, lacks any suggestion or motivation for making the combination. Any such objective reason can only be found in the teaching of the application in suit. Further, even if the mere fact that the prior art could be modified as proposed by the Examiner, it is not sufficient to establish a prima facie case of obviousness, In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Therefore, the cited art cannot be combined because all the elements of Applicant's amended claims 1, 3-7, 15 and 17 are not found.

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There must be a reasonable expectation of success

Prima facie obviousness requires that there must be a reasonable expectation of success when prior art is modified or combined. The '135 patent does not teach or describe using an active filter. Thus, this reference teaches away from using an active filter.

In summary, the combination of the above references does not meet the three basic criteria to establish a prima facie case of obviousness and Applicant respectfully submits that claims 1, 3-7, 15 and 17 are now in condition for allowance.

With regards to claims 2 and 16 being rejected under 35 U.S.C. 103(a) as being unpatentable over the '135 patent, admitted prior art and in view of Ciccarelli et al. (US Patent No. 6,359,940, claims 2 and 16 are dependent claims that depend from allowable independent claims as explained above and are in condition for allowance. Applicant also reiterate the previous remarks made about claims 1, 3-7, 15 and 17 herein and for the same reasons believes that claims 2 and 16 are in condition for allowance.

Response to Double Patenting Rejection


The Examiner relies on Tso et al (US Patent No. 6,856,794) in view of Woo et al. (US Patent No. 6,125,135) when issuing this rejection. Applicant is submitting a terminal disclaimer to overcome the double patenting rejection.

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Conclusion

In view of the foregoing arguments and the terminal disclaimer, Applicant respectfully submits that claims 1-7 and 12-18 as presented and in view of the remarks above are in a condition for allowance, for which action is earnestly solicited.

Respectfully submitted,

By 
Attorney for Assignee
Gregory B. Gulliver, Reg. 44,138
Phone: (847) 288-3551
Fax: (312) 264-2387

THE ECLIPSE GROUP
100 Tri-state International
Suite 128
Lincolnshire, IL 60069

Customer No. 34408